UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/765,885 | 01/29/2004 | Nobukazu Suzuki | 03500.017861. | 2302 |

5514 7590 12/30/2008

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

| EXAMINER | |
|---|---|
| ZHU, RICHARD Z | |
| ART UNIT | PAPER NUMBER |
| 2625 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 12/30/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/765,885 | SUZUKI, NOBUKAZU | |
| | Examiner | Art Unit | |
| | RICHARD Z. ZHU | 2625 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *10 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-6 and 15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Acknowledgement*

1. Acknowledgement is made of applicant's amendment made on 10/10/2008. Applicant's submission filed has been entered and made of record.

### *Status of the Claims*

2. Claims 1-6 and 15 are pending. Claims 7-14 are cancelled. Claims 1-6 are currently amended. Claim 15 is newly presented.

### *Response to Applicant's Arguments*

3. The prior arts of record do not disclose a plurality of film originals mounted with a slide mount. Therefore, the examiner vacates the previous grounds of rejection in favor of new grounds of rejection.
4. The primary reference Dow has been reviewed and it has been determined that certain aspect of it has been mischaracterized by the examiner. Appropriate corrections are reflected in the instant action.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1 and 15 are under 35 USC 103 (a) over ***Yoshida (US 6178005 B1)*** in view of ***Applicant Admitted Prior Art (AAPA)*** and ***Miyata et al. (US 4825250 A)***.

**Regarding the system of Claim 15 and therefore method of Claim 1,** ***Yoshida*** discloses a system for reading a plurality of originals which are placed on an original support of an image reading apparatus (**Fig 1 and see Col 3, Rows 28-34, a reading circuit 10 for reading a manuscript to generate image signals**), the system comprising:

an image reader for reading each of the images of the originals placed on the original support to generate image signals (**Fig 1 and see Col 3, Rows 28-34, reading circuit 10**);

a placement orientation detector for detecting placement orientation of the original as to whether it is landscape or portrait (**Col 5, Rows 6-15, a control circuit 36 incorporating a control program to manage the overall operations of the system to include determining whether received image signal is landscape or portrait; see for example Fig 5, S70 and S82**), based on lengths in horizontal and vertical directions of the image signal generated by said image reader (**Col 5, Rows 39-44 and see for examples Col 6, Rows 17-22 and Rows 64-67, a check to determine size and orientation of the image on the basis of the image signal as described by main scan length and sub-scanning length**);

an image signal rotator for rotating the image signal to be in a landscape placement (**Col 5, Rows 6-15, a control circuit 36 and see Fig 1, Length to Width Conversion Circuit 30, Col 4, Rows 10-18. To rotate an image by 90$^{o}$**), when the placement orientation of the original detected by said placement orientation detector is different from the landscape placement (**Fig 9, S212 and S214, when it is detected that placement orientation is portrait instead of landscape, S226, the image is length to**

**width converted or rotated by 90° and rotated into landscape placement. See Col 1, Rows 32-35**).

***Yoshida*** does not disclose:

1. reading a plurality of film originals mounted with a slide mount;

2. displaying said originals on a monitor unit connected to the image reading apparatus and therefore a read image signal display for displaying the plurality of read image signals on one display screen of the monitor unit in the landscape displacement and in a form of a thumbnail type display;

3. cutting out image areas in said image reading step.

The applicant admitted in ***AAPA*** that it is generally well known in the art of flat bed image reading apparatus to read a plurality of film originals mounted with a slide mount (**Page 1, lines 10-15 and Page 2, lines 1-5**) and displaying said originals on a monitor unit connected to the image reading apparatus and therefore a read image signal display for displaying the plurality of read image signals on one display screen of the monitor unit in a predetermined displacement and in a form of a thumbnail type display (**Page 1, lines 18-27, displaying a preview on a display device of a computer in thumbnails**).

The applicant further admitted that it is a general trend to display read image on a display device of a computer (**Page 2, lines 15-20**). Therefore, it would've been obvious to one of ordinary skill in the art at the time of the invention to the scanner apparatus of ***Yoshida*** to display thumbnail previews on a display device of a computer connected to the scanner apparatus so as to provide a friendly user interface. Therefore it would've been obvious to combined ***Yoshida*** and ***AAPA***.

The combined teachings do not teach an image area of the original placed on the original support is cut out to generate the image signal.

***Miyata*** discloses an image area of the original placed on the original support is cut out to generate the image signal (**Fig 12 and 14 and see Abstract**).

***Miyata*** teaches a common scanner and suggested a desire to conserve memory space by cropping only the necessary part of an image read (**Abstract, Trimming unnecessary image portions**).

It would've been obvious to one of ordinary skill in the art at the time of the invention to reprogram the scanner of the combined teachings with parameter to automatically generate a masking function and cut out an image area of the original as taught by ***Miyata***. The motivation would've been to "to provide an image forming apparatus which can automatically erase the unnecessary portions of a plurality of images set on the original plate and then automatically perform overlay of those image" (***Miyata,*** **Col 2, Rows 32-37**)

Therefore, it would've been obvious to modify the combined teachings with ***Miyata*** to obtain the invention.

**7.** Claims 2-6 are under 35 USC 103 (a) over ***Yoshida (US 6178005 B1)*** in view of ***Applicant Admitted Prior Art (AAPA)*** and ***Miyata et al. (US 4825250 A)*** further in view of ***Dow et al. (US 6784904 B2)***.

**Regarding Claims 2-6,** the combined teachings do not disclose providing an option to an user to make optionally rotations with respect to orientation. That is, it does not provide an user friendly interface that allows an user to perform various tasks optionally.

***Dow*** discloses a system (**Fig 1 A-D**) for displaying image information, wherein when image information of a plurality of originals that is different in its horizontal and vertical lengths placed on an original support is read by an image reading apparatus (**Fig 8C and 8F, the image captured is different in its horizontal length and vertical length**) and said read image is displayed on a display apparatus in a thumbnail display form (**Fig 2, Thumbnail View Module 82 and see Col 7, Rows 7-8**).

**Regarding Claim 2, *Dow*** discloses a method of displaying a read image signal further comprising a display orientation setting step (**Fig 1A, Rotation Button 32**) of setting said predetermined orientation (**Col 7, Rows 60-63**).

**Regarding Claim 3, *Dow*** discloses a method of displaying a plurality of read image signals further comprising

a second image signal rotation step of rotating said plurality of image signals by a predetermined angle (**Col 7, Rows 53-63, activation of rotation button will rotate said image signal by a predetermined angle**) irrespective of the placement orientation detected in said placement orientation detection step (**Col 7, Rows 53-57, the orientation detected in the default state is the placement orientation**), and

a second display orientation setting step of setting whether the images are to be displayed in the orientation aligned with said predetermined orientation or the images rotated by said second image signal rotation step is to be displayed (**If the user chooses to activate rotation button 32, the image that is rotated by $90^{o}$ relative to the placement orientation will be displayed by display 24**).

**Regarding Claim 4,** ***Dow*** discloses a method of displaying a read image signal wherein said second display orientation setting step can optionally set to display the image in the orientation detected in the placement orientation detection step (**Col 7, Rows 53-63, the user chooses not to activate the rotate button 32, the image will be displayed in an orientation that is originally detected when the image is initially captured**).

**Regarding Claim 5,** ***Dow*** discloses a method of displaying a read image signal wherein said second image signal rotation step further includes upon rotating the image signal by the predetermined angle, correcting its little inclination with respect to a vertical or horizontal direction (**Col 7, Rows 53-63, if the user chooses to activate the rotate button 32, the image will be displayed in an orientation that is rotated by a predetermined angle relative to the orientation originally detected when the image is initially captured. This is accomplished by correcting the inclination of the image signal with respect to a vertical or horizontal direction**).

**Regarding Claim 6,** ***Dow*** discloses a method of displaying a read image signal wherein in said image reading step, a plurality of originals placed on the original support are read (**scanning a plurality of original is determine by the user in accordance to user defined necessity**) and the other steps are performed on an image signal obtained from each of the originals individually (**Col 7, Row 63 – Col 8, Row 6, other steps includes magnifying, capture, send, delete, attach, detach and etc**).

Given the advantages of ***Dow***'s Device, it would've been obvious to one of ordinary skill in the art at the time of the invention to modify the display interface of the combined teachings to include features of ***Dow*** as cited in Claims 2-6 whereas the motivation would've

been to presents a novel user interface which makes the menu/image navigation user interface and method a solution in devices with limited resources which need to be able to navigate among multiple images arranged in different orientations (***Dow*, Abstract**).

## *Conclusion*

8. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Richard Z. Zhu whose telephone number is 571-270-1587 or examiner's supervisor King Y. Poon whose telephone number is 571-272-7440. Examiner Richard Zhu can normally be reached on Monday through Thursday, 0630 - 1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

$RZ^2$
12/23/2008

Richard Z. Zhu
Assistant Examiner
Art Unit 2625

/King Y. Poon/

Supervisory Patent Examiner, Art Unit 2625